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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/211,755	12/15/1998	KENNETH A. JONES	54002-D/JPW/	9496

7590

03/10/2003

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EXAMINER

BRANNOCK, MICHAEL T

ART UNIT

PAPER NUMBER

1646

DATE MAILED: 03/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/211,755

Applicant(s)

Jones, KA

Examiner

Michael Brannock

Art Unit

1646



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 30, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 208, 210, 213, 214, 221-225, 228, 230, 231, 233-239, and 250 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 233 and 234 is/are allowed.
- 6) ☒ Claim(s) 208, 210, 213, 214, 221-225, 228, 230, 231, 235-239, and 250 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Status of Application: Claims and Amendments

1. Applicant is notified that the amendments put forth in Paper 30, 1/30/03, have been entered in full.
2. Claims 208, 210, 213, 214, 221-225, 228, 230, 231, 233-239 and 250 are pending.
3. The finality of the previous office action is withdrawn. The indicated allowability of claims 208, 210, 213, 214, 221-225, 228, 230, 231, 235-239 and 250 is withdrawn in view of the newly discovered reference(s), U.S. Patent No: 6518399. Rejections based on the newly cited reference(s) follow.

Priority

4. This Application is a continuation in part of application 09186664. Claims 208, 210, 213, 214, 221-225, 228, 230, 231, 235-239 and 250 require a polypeptide that is either deposited in ATCC number 203515 or is SEQ ID NO: 47, i.e. a polypeptide that is human GABA_BR2. Neither ATCC number 203515 nor SEQ ID NO: 47 are disclosed in the 09186664 application. Thus, claims 208, 210, 213, 214, 221-225, 228, 230, 231, 235-239 and 250 are given the priority date of the instant Application, 12/15/98.

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New Rejection:

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 208, 210, 213, 214, 221-225, 228, 230, 231, 235-239 and 250 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No: 6518399.

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U.S. Patent No: 6518399 disclose assays for agonists of a GABA_BR1/R2 receptor (e.g. col 14), wherein the GABA_BR1 polypeptide is either the rat GABA_BR1a or GABA_BR1b polypeptide (e.g. col 2), each of which is 100% identical to the instant SEQ ID NO: 56 and 55, respectively, and wherein the GABA_BR2 polypeptide is the human GABA_BR2 (e.g. col 4) that is 100% identical to the instant SEQ ID NO: 47. Assays are also disclosed wherein the activity is measured via changes in cAMP, GTPγS incorporation, or GIRK1 and GIRK4-evoked changes in current, see cols 5 and 6. The use of the human GABA_BR2 polypeptide in such assays is fully supported in prior US application 60/103,670, filed October 9, 1998.

Allowable Subject Matter

7. Claims 233 and 234 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Brannock, Ph.D., whose telephone number is (703) 306-5876. The examiner can normally be reached on Mondays through Thursdays from 8:00 a.m. to 5:30 p.m.

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The examiner can also normally be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, Ph.D., can be reached at (703) 308-6564.


Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

MB



March 1, 2003


YVONNE EYLER, PH.D.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600